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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): YOR920030535US1

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Application Number	Filed
10/724,845	12/01/2003

First Named Inventor: Robert W. Wisniewski

Art Unit	Examiner
2151	Walsh, John B.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 31,686.
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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May 13, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Tradeamrk Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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Arguments Accompanying Pre-Appeal Brief Request For Review

Claims 1-14 and 16-36 were rejected under 35 U.S.C. §102(e) as being anticipated by Reed (US 2002/0095454). Claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over Reed (US 2002/0095454) in view of Wolton et al. (US 2004/0030741).

Independent claim 1 claims a communication system comprising a database and a database agent. The database agent is **adapted to** determine if a communication has a task tag. The database agent is **adapted to** transfer predetermined communication tag information of the task tag of the communication to the database. The database agent is **adapted to** automatically send a communication based upon information stored in the predetermined communication tag information.

In the office action mailed 10/9/2007 the examiner stated that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform; that it does not constitute a limitation in any patentable sense (citing In re Hutchison). In the office action mailed 04/04/2008, the examiner stated that he is not ignoring the "adapted to" clauses, but is giving the claims the "broadest reasonable interpretation" meaning that the "adapted to" clauses only require the ability to perform a function and, thus, Reed et al. anticipates the claims since it discloses equivalent structure that is "adapted to" perform the function.

As pointed out to the examiner in the Amendment filed 1/4/2008, In re Hutchison holds that the term "adapted to" used in the **preamble** is not given patentable weight. However, In re Venezia 189 USPQ 149 (CCPA 1976) explicitly held that the phrase "a pair of sleeves *** each sleeve of said pair *adapted to* be fitted over the insulating jacket of one of said cables" **imparts a structural limitation** to the sleeve. The court went on to hold that the language "adapted to be affixed" and "adapted to be positioned" also defines present structures or attributes of the part which limits the structure of the housing. Thus, it appears that In re Hutchison only applies to the **preamble** of a claim, not the **body** of a claim.

MPEP 2111.04 specifically addresses "adapted to" language. The determination of whether an "adapted to" clause is a limitation in a claim depends on the specific facts of the case. In this case, reading the language of claim 1, the "adapted to" clauses are clearly limitations in the claim.

In regard to the examiner's belief that Reed et al. "anticipates" claim 1, the Panel is directed to MPEP 2131. Anticipation requires that **each and every element** of the claimed invention be disclosed in a single prior art reference (emphasis added). In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Anticipation requires **identity** of the claimed invention (emphasis added). Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985). For anticipation, there must be **no difference** between the claimed invention and the reference disclosure (emphasis added). Scripps Clinic & Res. Found. V. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). The corollary of the rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

In the present case, the examiner has not proven that there is **identity** between the cited reference and the features of claim 1. In the present case, the examiner has not proven that **each and every element** of the claimed invention is disclosed in the cited reference. In the present case, the examiner has not proven that there are **no differences** between the claimed invention and the reference disclosure.

The examiner has stated that "11" in Reed et al. is equivalent to applicants' claimed database and that somehow paragraphs 0031 and 0090 disclose applicants' claimed database agent. This appears to be in error. Although "11" is a database, there is no disclosure or suggestion in paragraphs 0031 and 0090 of Reed et al. of a database agent adapted to determine if a communication has a task tag. There is no disclosure or suggestion in paragraphs 0031 and 0090 of Reed et al. of a database agent adapted to transfer predetermined communication tag information of the task tag of the communication to the database 11. There is no disclosure or suggestion in paragraphs 0031 and 0090 of Reed et al. of a database agent adapted to automatically send a communication based upon information stored in the predetermined

communication tag information. Reed et al. simply does not "anticipate" the features recited in claim 1. Therefore, claim 1 is patentable and should be allowed.

Independent claim 13 claims a method for automatically tracking progress of a task on a computer network consisting of one or more users on a plurality of computer systems, the method comprising:

> tagging a communication to be delivered between the computer systems over the network to form a tagged communication; and
>
> acting on the tagged communication automatically by a database agent.

The examiner indicated that paragraphs 0031 and 0090 of Reed et al. anticipated this claimed method. This is incorrect. Paragraph 0031 of Reed et al. merely describes that a provider program (12) is used to create, edit, and maintain data, metadata and instructions in a provider database (11). The provider program (12) controls distribution of the information to various consumers. Different information contained in the provider database (11) can be transferred and used in communications relationships with different consumers. The provider program (12) also receives and uses information from the consumer computer (2) to control encoding and transfer of information to the consumer computer (2). Paragraph 0090 of Reed et al. merely describes that appropriate programs executing on the provider computer 1 and the consumer computer 2 perform the functions necessary to transfer, maintain, and update the information at both locations. The provider program 12 operates to transmit changes in information stored in the provider database 11 at the provider computer 1. When changes are made to the information and the database, the provider program 12 operates to disseminate the changed information through the communications network 3. Upon receipt of changed information, the consumer program 22 operates to perform certain functions with regard to that changed information. Principally, the information is stored in consumer database 21 on the consumer computer 2 for future reference and usage in controlling and automating communications between the consumer and provider.

Neither paragraph 0031 nor paragraph 0090 of Reed et al. disclose or suggest a method for automatically tracking progress of a task on a computer network consisting of one or more users on a plurality of computer systems, the method comprising:

> tagging a communication to be delivered between the computer systems over the network to form a tagged communication; and
>
> acting on the tagged communication automatically by a database agent.

The features of claim 13 are certainly not "anticipated" by the disclosure in paragraphs 0031 and 0090 of Reed et al.

Independent claim 33 claims a system for tracking tasks comprising:

> a communication system adapted to attach a task tag to a communication; and
>
> a tracking system separate from a communication sending computer and a communication receiving computer which is adapted to automatically enter predetermined information of the task tag of the communication into a database.

Reed et al. clearly does not disclose a communication system adapted to attach a task tag to a communication; and a tracking system separate from a communication sending computer and a communication receiving computer which is adapted to automatically enter predetermined information of the task tag of the communication into a database. Thus, Reed et al. does not "anticipate" the features of claim 33. The examiner is requested to reconsider his rejection.

Independent claim 34 claims a method of tracking tasks comprising sending a communication; attaching a task tag to the communication; recording, by an automatic database agent, at least a portion of data in the task tag into a database; and automatically sending a communication by the automatic database agent based, at least partially, on the data in the task tag. The paragraphs of Reed et al. cited by the examiner do not disclose attaching a task tag to the communication; recording, by an automatic database agent, at least a portion of data in the task tag into a database; and automatically sending a communication by the automatic database agent based, at least partially, on the data in the task tag.

Paragraph 0093 discloses that the consumer database 21 can include instruction, and that the provider can include special forms to be processed by the consumer program 22 to automatically transfer data from the consumer database 21 back to the provider, and paragraph 0180 mentions a header tag. However, there is no disclosure or suggestion attaching a **task tag** to the communication; recording, by an automatic database agent, at least a portion of data in the task tag into a database; and automatically sending a communication by the automatic database agent **based,** at least partially, **on the data in the task tag**. Reed et al. does not "anticipate" the features recited in claim 34. Therefore, claim 34 is patentable and should be allowed.

Independent claim 35 claims a program storage device with a program of instructions to perform a method comprising searching a first communication to determine if the first communication has a task tag, the task tag comprising a task topic and a task progress; and automatically sending a second communication by an automated database agent based upon data in the task tag. The paragraphs of Reed et al cited by the examiner do not disclose a communication having a task tag comprising a task topic and a task progress; much less searching a first communication to determine if the first communication has a task tag. The paragraphs of Reed et al cited by the examiner do not disclose automatically sending a second communication by an automated database agent based upon data in a task tag. The features recited in claim 35 are not disclosed or suggested in the cited reference. Therefore, claim 35 is patentable and should be allowed.

Independent claim 36 claims a program storage device with a program of instructions to perform a method for tracking tasks comprising creating a communication; and attaching a task tag to the communication comprising a task topic and a task progress. Reed et al. does not disclose a task tag; much less a task tag comprising a task topic and a task progress. Thus, Reed et al. clearly does not disclose attaching a task tag to a communication comprising a task topic and a task progress as recited in claim 36. Reed et al. clearly does not "anticipate" the features recited in claim 36. Therefore, claim 36 is patentable and should be allowed.